

1. Claims 2-5, 7-11 and 13-16 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berry *et al.* in view of Cirne *et al.* and in further view of Ono *et al.* (U.S. Patent No. 5,794,040). Applicants traverse the rejection of claims 2-5, 7-11 and 13-16 for at least the reasons discussed below.

The burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless of whether the USPTO

relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The Patent Office acknowledges that *Berry et al.* do not disclose comparing a keyboard event with keys through a hierarchical tree structure to find a key that corresponds to a keyboard event. The Patent Office claims that *Berry et al.* disclose that, in the case of a keyboard event, the next consecutive object will be determined according to the compound object’s hierarchy, but Figure 7A of *Berry et al.* is clear that if the keyboard event does not change the navigational level, then the keyboard event is directed to a child object that can handle the keyboard event. Keyboard events are not passed towards parent objects. The Patent Office alleges, however, that *Cirne et al.* provide the requisite disclosure to overcome the acknowledged deficiencies of *Berry et al.*

The combination of *Berry et al.* and *Cirne et al.* fails to teach or suggest comparing a keyboard event to the keys listed in key lists, starting with the key list associated with an active graphical element and traversing a hierarchical tree of parent graphical elements and child

graphical elements towards the root of the tree if the keyboard event was not found in the key list associated with the active graphical element, as recited in claim 2. The combination of Berry *et al.* and Cirne *et al.* do not teach or suggest traversing the hierarchical tree if the keyboard event is not found in the key list associated with the active graphical element. As noted above, the Patent Office acknowledges that Berry *et al.* do not disclose comparing a keyboard event with keys through a hierarchical tree structure to find a key that corresponds to a keyboard event. As noted above, with respect to steps 263, 265, 267 and 269 as shown in Figure 7A of Berry *et al.*, if the keyboard event does not change the navigational level, then the keyboard event is directed to an object that can handle the keyboard event. Berry *et al.* disclose that the direction of the passing of the keyboard events is towards child objects, not parent objects. Steps 265 and 267 are repeatedly executed until a child object that can handle the keyboard event is located.

Furthermore, Berry *et al.* disclose that only one level is active at a time, and there is no teaching or suggestion that the “active level” is an active graphical element. *See* col. 5, lines 2-5.

Furthermore, in Berry *et al.*, each keyboard event has a universal meaning (*i.e.*, go to the right or change level) irrespective of whatever graphical element is active. Each keyboard event has only one possible meaning and can only be associated to one action, and is thus independent of whatever graphical element is active. In other words, in Berry *et al.*, the action that results from a keyboard event is unchanging, and is not influenced on the basis of whether or not a particular graphical element is active. Cirne *et al.* disclose a focus event structure (800) that includes an event data key (802) and an event data field (804). *See* Figure 8, col. 7, lines 61-67 of Cirne *et al.* Specifically, Cirne *et al.* disclose an event handling mechanism that routes keyboard events

to the right object in order to have the right action performed. The event handling mechanism takes charge of the routing of keyboard events, and there is no teaching or suggestion in Cirne *et al.* that the event handling mechanism is influenced in any manner by whether or not a particular graphical element is active. Furthermore, the global routing event mechanism of Cirne *et al.* is incompatible with the navigational mechanism of Berry *et al.*, since these are two different philosophies of handling keyboard events. Finally, Cirne *et al.*, like Berry *et al.*, handles events in a parent object to child object fashion; neither reference passes keyboard events in a child to parent fashion, as recited in claim 2.

The Patent Office has implicitly acknowledged that the combination of Berry *et al.* and Cirne *et al.* fail to teach or suggest a comparison that involves traversing a tree composed of parent graphical elements and child graphical elements towards its root if the keyboard event was not found in the key list associated with the active graphical element. However, the Patent Office alleges that Ono *et al.* supplies the necessary disclosure to overcome the implicit acknowledgment that the combination of Berry *et al.* and Cirne *et al.* fail to teach or suggest traversing the graphical element tree towards its root if the keyboard event was not found in the key list associated with the active graphical element.

The combination of Berry *et al.*, Cirne *et al.* and Ono *et al.* fails to teach or suggest comparing a keyboard event to the keys listed in key lists, starting with the key list associated with an active graphical element and traversing a hierarchical tree of parent graphical elements and child graphical elements towards the root of the tree if the keyboard event was not found in the key list associated with the active graphical element, as recited in claim 2. The Patent Office

has impermissibly broadened the disclosure of Ono *et al.* to embrace the claimed subject matter. The bottom-up calculation is not related to the search through key lists from a child graphical element to a parent graphical element in order to find a match for a keyboard event, since no search back through a hierarchical tree is taught or suggested. Furthermore, although Figure 12 of Ono *et al.* might appear to disclose a search back through a hierarchical tree, Ono *et al.* disclose that pointers to an updated value are being exchanged. Critically, Figures 10a-10c of Ono *et al.* show various arrangements for the Event Source calculation, but none show a search path traversing a hierarchical tree towards its root. Moreover, Figure 9 shows Event Source paths from the root to the child operations, but does not show paths from the child operations back to the root. In sum, Applicant submits that the Patent Office cannot fairly point to any teaching or disclosure within Ono *et al.* of a search through key lists from a child graphical element to a parent graphical element in order to find a match for a keyboard event. Therefore, the combination of Berry *et al.*, Cirne *et al.* and Ono *et al.* fail to teach or suggest that a keyboard event is passed to higher level objects if no object that could handle the keyboard event is present in the current navigation level, or that the keyboard event is influenced by whether or not a particular graphical element is active. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Berry *et al.*, Cirne *et al.* nor Ono *et al.* disclose comparing a keyboard event to the keys listed in key lists, starting with the key list associated with an active graphical element and traversing a hierarchical tree of parent graphical elements and child graphical

elements towards the root of the tree if the keyboard event was not found in the key list associated with the active graphical element, Applicants submit that one of ordinary skill in the art would not have combined the two references. Although the Patent Office provides a motivation analysis with respect to the comparison of keylists to keyboard events, *Berry et al.*, *Cirne et al.* and *Ono et al.* lack any teaching about the desirability of traversing the hierarchical tree if the keyboard event is not found in the key list associated with the active graphical element. As discussed above, *Berry et al.* and *Cirne et al.* disclose entirely incompatible methods for handling keyboard events, and *Ono et al.* lack any disclosure of traversing hierarchical trees from child objects to parent objects. Given the complete lack of several elements of the invention recited in claim 2, one of skill in the art would not have been motivated to combine the three disparate references to create the present invention. There must be some showing of the obviousness of the claim as a whole, not the discrete parts to establish *prima facie* obviousness. When the art in question, as is the case here, is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999), *limited on other grounds by In re Gartside*, 203 F.3d 1305 (2000). The same principle applies here because Patent Office's analysis is backward to achieve the end point already defined, *i.e.*, independent claim 2. *Prima facie* obviousness is a legal requirement and the burden is on the Patent Office to demonstrate using only objective evidence or suggestion from the applied prior art, that one of ordinary skill would have been lead to the claimed invention as a whole without recourse to Applicants' disclosure. *In re Oetiker*, 977 F.2d 1443, 1447-48 (Fed. Cir. 1992); *In re Fine* 837

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F.2d 1071, 1074-75 (Fed. Cir. 1988). As a matter of law then, it is the burden of the Patent Office to demonstrate that the prior art, and not Applicants' disclosure, would lead the hypothetical artisan to the claimed invention as a whole. What the Patent Office has done, and as plainly apparent in the statement of rejection, is to dissect the claim into discrete components and then to apply individual pieces of prior art. That is the hallmark of hindsight and not the characteristic of obviousness. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of *Berry et al.*, *Cirne et al.* and *Ono et al.* fails to disclose all of the claimed elements as arranged in claim 2. Therefore, the combination of *Berry et al.*, *Cirne et al.* and *Ono et al.* clearly cannot render the present invention obvious as recited in claim 2. Thus, Applicants submit that claim 2 is allowable, and further submit that claims 3-5 and 14 are allowable as well, at least by virtue of their dependency from claim 2. Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 2-5 and 14.

Independent claim 7 has similar recitations as independent claim 2. Applicants submit that claim 7 is allowable over the combination of *Berry et al.*, *Cirne et al.* and *Ono et al.* for the similar reasons as claim 2, namely the lack of disclosure with respect to the comparison of key lists upon receipt of a keyboard event and traversing the hierarchically related graphical elements toward the parent graphical elements to find a key within the key lists that corresponds to the keyboard event. For the sake of brevity, Applicants incorporate by reference the claim 2

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arguments concerning the “all limitations” and motivation prongs of a *prima facie* case of obviousness as applying to claim 7 as well. Applicants further submit that claims 8-10 and 15 are allowable as well, at least by virtue of their dependency from claim 7. Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 7-10 and 15.

Claim 11 has similar recitations as claim 2. Applicants submit that claim 11 is allowable over the combination of Berry *et al.*, Cirne *et al.* and Ono *et al.* for similar reasons as claim 2, namely the lack of disclosure with respect to the comparison of key lists upon receipt of a keyboard event and traversing the hierarchically related graphical elements toward the parent graphical elements to find a key within the key lists that corresponds to the keyboard event. For the sake of brevity, Applicants incorporate by reference the claim 2 arguments concerning the “all limitations” and motivation prongs of a *prima facie* case of obviousness as applying to claim 11 as well. Applicants further submit that claims 13 and 16 are allowable as well, at least by virtue of their dependency from claim 11. Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 11, 13 and 16.



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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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Date: July 30, 2004